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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/779,558 | 02/09/2001 | Yuichi Itoh | 1254-0170P | 6155 |

2292 7590 09/09/2004

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| EXAMINER |
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EGWIM. KELECHI CHIDI

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1713

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|------------------------------------|--|
| Office Action Summary | Application No. 09/779,558 | Applicant(s) ITOH ET AL. | |
| | Examiner Dr. Kelechi C. Egwim | Art Unit 1713 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004 and 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 9,10,14-16 and 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,11-13 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/21/2004 has been entered.

Election/Restrictions

2. Claims 9,10,14-16 and 21-24 are still present in the application, but remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in paper No. 5.

Claim Rejections - 35 USC § 102/103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-8, 11 and 17-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Rinehart (USPN

4,220,579), Mathews et al. (USPN 4,239,862) or Abdou-Sabet et al. (USPN 4,311,628), for reasons cited in prior Office actions.

5. Claims 1-8, 11-13 and 17-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Sezaki et al. (USPN 4,728,692) or Ottawa et al. (USPN 4,818,785), for reasons cited in prior Office actions.

Response to Arguments

6. Applicant's arguments filed 06/21/2004 and 07/14/2004 have been fully considered but they are not persuasive.

7. Regarding applicant's arguments that applicant cannot submit further data regarding the paraffinic oils described in Matthews et al., Abdou-sabet et al. or Sezaki et al. since several the cited oils relied upon by the Examiner are not available and/or not sufficiently described such that they cannot be obtained, tested and evaluated, this does not amount to non-enablement sufficient for nullification of the teaching in the prior art. When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See MPEP § 2121 & 716.07.

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8. Regarding applicants arguments against the oil in Example 12 of Ottawa et al., the 0.05% evaporation loss of PW 380 meets the requirements of "an evaporation loss of 0.4% or less" as presently claimed.

9. Regarding applicant's arguments that the prior art paraffinic oils "have properties which are similar to those of Sun Par Super M100, ... PW-90 [and] Tufflo 6056" and the 132 declaration, as already stated in the advisory action, the data that is so far presented and useful in comparing the oils represented in the chart of the after final response are flash-point and density. However, while, based on the comparison of these two properties, the paraffins of Rinehart and Matthews et al. are comparable with that of the oil of comparative example 3 (c-3) in applicant's specifications, it is also noted that these properties of the c-3 (flash-point and density) are just as comparable with the invention reprehensive oils of applicant's examples 1 and 2. No conclusion of unexpected results or properties can be drawn from this chart since applicant's own oils also have properties (flash point and density) comparable with the comparative c-3 oil.

10. Regarding applicant's arguments that the cited prior art does not disclose the claimed properties, as stated in the previous action, while the prior art may not expressly teach the disclosed properties in the claimed composition (i.e., the evaporation loss or kinetic viscosity of the paraffinic oil), it is still reasonable that the composition of the prior art would possess the presently claimed properties since the compositions, including the paraffinic oils **as claimed**, are essentially the same as the

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claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is still not patentable regardless of any new or unexpected properties. In *re Fitzgerald et al*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

11. Finally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the oils are obtain by cutting low molecular weight components from a commercially available paraffinic oil) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

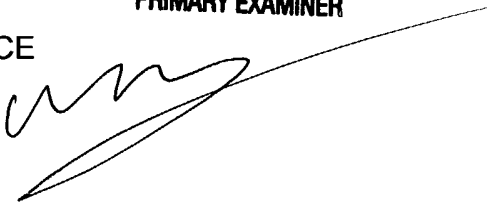
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

KCE

A handwritten signature in black ink, appearing to be 'KCE' followed by a stylized flourish, is written over the printed name and title of the examiner.